

**Response to Detailed Action Item 4 and 5****Remarks – General**

By the above amendment, Applicant has rewritten the claims to define the invention more particularly and distinctly so to define the invention patentably over the prior art.

The rejection of Claim 1 On Maynes and Thater is overcome.

The last O.A. rejected independent claim 1 on Maynes and Thater. Claim 1 has been rewritten as new claim 9 to define the invention more particularly and distinctly so as to overcome the rejections and define the invention patentably over these references, and any combination thereof. **Applicant requests reconsideration of this rejection, as now applicable to claim 9, for the following reasons:**

- (1) Maynes and Thater take mutually exclusive paths and reach different conclusions to a similar problem. Since they teach away from each other, it would not be logical to combine them.**
- (2) It would be necessary to make modifications, not taught by Maynes and Thater or in any other prior art separate from applicant's disclosure, in order to combine the references in the manner suggested.**
- (3) These novel physical features of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references.**

**The References and Differences of the Present Invention Thereover**

Prior to discussing the claims and the above three points, applicant will first discuss the references and the general novelty of the present invention and the unobviousness over the references.

Maynes presents a two-sided portable scoreboard. The examiner notes in the last O.A. that the device disclosed by **Maynes is rigid, rather than being flexible**. Maynes does

not consider nor present any configuration, art or suggestion of the scoreboard and/or its self-contained scoring elements capable of being foldable or capable of being “rolled up” upon itself into a compact cylindrical form. Maynes does not do this, but Applicant does.

**Thater** discloses a tennis scoring device whereby **paddle-shaped markers** are used as the **scoring elements**. These paddle-shaped markers serve as the game and set scoring indicators. To keep score, these paddle-shaped markers are removed and replaced into scoring pockets. Thus the **scoring elements are a separate component** of the scoring apparatus housing and therefore **are not self-contained within the housing**.

Thater does present a foldable scoring housing. Thater, however, presents no reference or art to show the scoring elements, used for scoring, being capable of form fitting within the housing into its folded configuration. In fact, **Thater states** the exact opposite as follows,

(see Thater, 4,831,956 - p.14, 6. 65-68): **“It should be also noted that it is preferred that the game and set scoring indicator markers be removed from said tennis scoring apparatus prior to folding it into its portable configuration.”** Thater therefore recognizes the problem of having rigid scoring elements being included in a foldable housing.

**Thater does not solve the problem of a scoring element being form fitting in conjunction with a flexible housing but Applicant does.**

Applicant has amended Claim 9 to reflect the novel feature of the device, specifically the ability of the scoring element to form fit into the shape of a flexible housing. Claim 9 amended specifically to state the novel feature of the device over the references as follows:

“said scoring elements of the type comprising a sheet of lightweight, flexible second material capable of being repeatedly bent and straightened out without fracturing,

**whereby said scoring elements have the means to conform and form fit to the various flexible shapes formed by said housing,”**

**Maynes and Thater take mutually exclusive paths and reach different conclusions to a similar problem. Since they teach away from each other, it would not be logical to combine them.**

Referring to the last O.A. regarding Thater that it was known art to make a flexible scoring device that can be rolled-up for compact storage, it should be noted that Thater chose a different and mutually exclusive path to a scoring device as chosen by Maynes. **Maynes chose to secure and permanently attach his scoring elements** within the front plate and back plate of his scoring device using (see Maynes, 4,280,291 - p5, 3. 42-44): “rivots, pins, or bolts, with appropriate washers and nuts to axially mount each scoring element”. Thater chose to incorporate removable paddle shaped markers as his scoring elements which are moved from one scoring pocket to another. Thus the **scoring elements disclosed by Thater are not permanently attached and self-contained** to the scoring device as Maynes discloses.

**Considering the significant differences** in the conclusions drawn by Maynes and Thater **it would not be obvious** to one having ordinary skill to apply Thater to Maynes. To conclude that Maynes scoring device could be made to be flexible and capable of being rolled-up for compact storage one would have to ignore the mutually exclusive paths

chosen regarding the self-contained scoring elements of Maynes and the paddle shaped removable scoring elements of Thater.

**It would be necessary to make modifications, not taught by Maynes and Thater or in any other prior art separate from applicant's disclosure, in order to combine the references in the manner suggested.**

Specifically to apply Thater to Maynes regarding a flexible scoreboard, capable of being folded or "rolled upon itself", one would need to make significant modifications to Thater.

**Thater's scoring elements are separate, removable and not included in the folded and portable configuration.**

Thater discloses set and game paddle shaped markers referred to by the applicant as scoring elements as removably insertable into the pockets of a flexible housing. Referring to Fig. 1 of Thater, the scoring device housing is shown folded upon itself, however **no indication of the paddle shaped markers capable of conforming to the flexible housing is provided nor even included in the folded configuration. Thater, in fact, instructs the opposite by stating, (see Thater, 4,831,956 - p.14, 6. 65-68): "It should be also noted that it is preferred that the game and set scoring indicator markers be removed from said tennis scoring apparatus prior to folding it into its portable configuration." Fig. 1 of Thater does not refer to the removable paddle shaped markers being included in the folded configuration thus further supporting Thater's instructions.**

**Maynes and Thater's scoring device components are rigid and not flexible.**

As the last O.A. states, Maynes self-contained scoring device is rigid, rather than flexible. With regard to it being obvious to one having ordinary skill in the art to make the device disclosed by Maynes to be flexible and capable of being rolled upon itself into a compact and cylindrical form, one would need to modify Maynes to Thater or Thater to Maynes.

To apply Thater to Maynes, one would need to remove the disk shaped scoring elements by removing the (see Maynes, 4,280,291 - p5, 3. 42-44) "rivots, pins, or bolts, with appropriate washers and nuts" and detach the axially mounted scoring elements from within the front and back plates. Furthermore, one would need to add scoring pockets to the front plate of Maynes scoreboard and eliminate the disk shaped scoring elements for a shape capable of being secured by the new scoring pockets, such as the paddle shape scoring elements of Thater. Maynes does not teach of these modifications.

To apply Maynes to Thater the modifications would require making the components capable of conforming to the rolled up, cylindrical and compact form of the housing, which Thater does not teach. Thater does provide for a scoring device foldable about itself. Thater indicates the use of scoring placards which are marked with scoring indicia. Thater teaches that (see Thater, 4,831,956 – p 12, 2. 24-27) "two of each paddle shaped markers are present with the scoring apparatus so they may be used in conjunction with the two tennis scoring placards (preferably composed of a hard plastic such as Lucite.TM.)" **The use of hard Lucite plastic would force the housing to conform to the shape of the hard Lucite plastic components not the components to the housing. Since the hard Lucite plastic components are not capable of being rolled into a compact cylindrical form then the housing would not be capable of it as well. That is unless the hard plastic components are removed before folding, (as Thater indicates**

**for the paddle shaped scoring markers) which would further argue the point that the scoring device is not self contained. Thus Thater teaches the housing must be removed before folding, while Applicant provides for the components to be self-contained and form fitting to the housing.**

**Applicant's scoring device components is self-contained.**

**As shown in Fig. 5 of Applicants drawings, Applicant provides a means for rolling up and securing the self-contained scoring banner into a relatively compact cylindrical configuration for storage and transportation. Self-contained defined as including the housing, scoring elements, scoring indicia, and scoring titles. In addition the device is secured in the cylindrical configuration using the attachment devices such as bungee cords. This provides for a complete and self-contained scoring device in a compact and cylindrical form ready for transport and storage.**

**Applicant's scoring device components are both self-contained and form fitting to the housing.**

**In summary, Applicant provides for a flexible scoring device including self-contained flexible scoring elements which conforms and form fits to the scoring device housing. Maynes provides for a rigid scoring device and Thater provides for a foldable device contingent on the removal of the scoring elements as well as the characteristics of the hard Lucite (not flexible) plastic components. Therefore in the present, significant modifications would need to be made, not taught by Maynes and Thater or in any other prior art separate from applicant's disclosure, in order to combine the references in the manner suggested.**

**These novel physical features of claim 9 produce new, unexpected and superior results and hence are unobvious and patentable over these references.**

Also applicant submits that the novel physical features of claim 9 are also unobvious and hence patentable under section §103 since they produce new and unexpected results over Maynes and Thater, or any combination thereof.

**Applicant provides the means for a flexible scoring element which conforms to the shape of the flexible housing. This novel physical feature overcomes the problems faced by Maynes or Thater or prior art. Maynes provides for a rigid scoring devices and Thater provides for flexible scoring devices with rigid and removable components. Applicant provides the novel feature of having a self-contained flexible scoring device with flexible and form fitting components. The unexpected result of this unique design includes the ability to have a lightweight self-contained scoring device capable of being rolled upon itself into a compact cylindrical form for easy transport and storage.**

The use of flexible self-contained components in conjunction with a flexible scoring device housing was not done before, so neither it nor its contingent advantages were known or appreciated.

### **Conclusion**

For all the above reasons, applicant submits that the claims of this application are now proper, definite, and define novel structure which is also unobvious. Therefore applicant submits that Claim 9 is allowable over the cited references and solicits reconsideration and allowance. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 2173.02 and § 707.07 (j) in order that the

undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

**The rejection of Claim 5 is overcome.**

Applicant has amended Claim 10 to reflect the novel feature of the device, specifically the ability of the scoring banner to have the means to hold and secure as well as display at least one mascot toy. Claim 10 amended specifically to state the novel feature of the device over the references as follows:

“The scoring banner of claim 9 further comprising a **means to hold, secure and display** at least one team mascot toy.”

The last O.A. rejected independent claim 5, stating a team mascot toy could be perched on the top of the display. Therefore, the top of the display constitutes means for displaying a team mascot toy. **Applicant requests reconsideration of this rejection, as now applicable to claim 10, for the following reasons:**

- (1) The prior art reference that was relied upon is inoperative.**
- (2) The problem solved by the invention was never before recognized. The recognition of an unrecognized problem militates in favor of patentability.**

**The prior art reference that was relied upon is inoperative.**

Maynes presents a rigid scoreboard. In his preferred embodiment as shown in Fig. 1, the scoring element disks protrude above the housing. In Fig. 6, the scoreboard is mounted to a frame, with the top of the housing covered by the frame. It would not be possible as presented to perch the team mascot toy on the top of the scoreboard due to the protrusion of the disks while in the top presentation of the scoring elements or the intrusion of the frame for the bottom scoring element presentation.



Even if a means or room were found to perch the team mascot toy on top of the device or the frame, the team mascot toy would not be secure. If the device were bumped, or if weather elements were introduced, the team mascot toy would fall off the device as disclosed by Maynes.

The Applicant has provided a means to secure and display a team mascot toy by providing for a flexible team mascot toy pocket on the front face of the housing. This pocket will hold and secure the team mascot toy in any reasonable weather conditions where a sporting event would be played.

The problem solved by the invention was never before recognized. The recognition of an unrecognized problem militates in favor of patentability.

Maynes does not recognize nor is there any other prior art that recognizes the need to hold, secure and display a team mascot toy on a scoring device. The Applicant has recognized this problem and through Claim 10 produces new, unexpected and superior results and hence is unobvious and patentable over this and or any other prior reference.

For all the above reasons, applicant submits that the claim is now proper, and that the claim defines patentably over the prior art. Therefore applicant submits that Claim 10 is allowable over the cited references and solicits reconsideration and allowance. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 2173.02 and § 707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

**Response to Detailed Action Item 1 and 2****Remarks – General**

Applicant requests guidance on the election of Species I as to how it pertains to the drawings. Specifically in O.A. #1, Species were identified as follows:

Species I., Figs. 1-3 and 5.

Species II., Figs. 11;

Species III., Figs. 12;

Species IV., Figs. 13;

Species V., Figs. 14;

Species VI., Figs. 15-16;

Species VII., Figs. 17-19;

Species VIII., Figs. 20-22;

Species IX., Figs. 23.

Applicant would like to note that Fig. 4, Fig. 6 and Fig. 10 were not identified under any of the Species. Applicant would request guidance on the applicability of Fig. 4, Fig. 6 and Fig. 10 to Species I. Applicant suggests that Fig. 4, Fig. 6 and Fig. 10 provide alternative displays of the embodiment of Species I. In addition, Applicant requests guidance on the distinction of Species II (Fig. 12) and Species III (Fig. 13) from Species I. Applicant suggests that Species II and III represent the same embodiment of Species I, with the distinction of multiple scoring elements in a different sports venue.

**If Applicant successfully obtains allowance of claims 9 and 10, can Applicant present Fig. 4, Fig. 6, Fig 10, and/or Species II and Species III as a part of the patent artwork? Applicant would suggest that these alternate embodiments are represented in Claim 9 and 10.**

**Response to Detailed Action Item 3****Remarks – General**

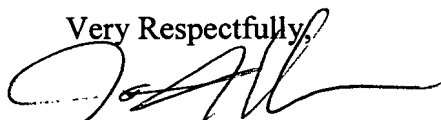
Claim 4 (sound device) was canceled.

Any additional drawing objections will be corrected after allowance.

**Further Assistance Requested**

If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 2173.02 and § 707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings. **Applicant would request a phone meeting at the convenience of the examiner to discuss examiners review to further assure defined protocol, rules and regulation of the patent office are met.** Applicant can be reached at [jhaconsults@gmail.com](mailto:jhaconsults@gmail.com) to arrange such meeting at examiners convenience. Applicant would like to thank the examiner for his consideration and efforts on behave of the Patent Office and the Applicant.

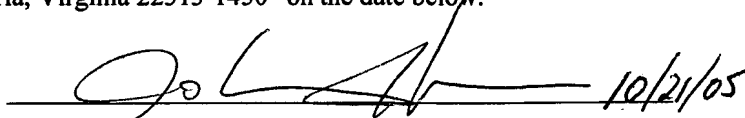
Very Respectfully,



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10/21/05



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